

## SECTION II REMARKS

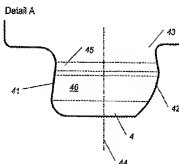
### Regarding the Amendments

Claims 1, 5, 6, and 11 have been amended as set forth in the above Complete Listing of the Claims. As amended, the claims are supported by the specification and the original claims. No new matter has been added, as defined by 35 U.S.C. § 132.

Specifically, claim 1 has been amended to recite “viewed in the direction from the utilization side to the counter draw,” rather than the original language “viewed in the direction of the utilization side.” Such amendment is fully supported by the figures and the written description of the application. The word “of” was originally included in the claims as inaccurate translation of the German preposition *von* which can be translated into English as either “of” or “from.”

Claims 1 and 11 have been amended to include the phrases “comprising a root region of the connecting element” and “the cross-section of the connecting element having...” along with additional description of the cross section. Support for these amendments is in the specification at page 8, 2<sup>nd</sup> paragraph.

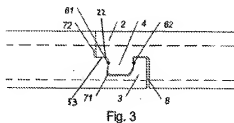
Claims 1 and 11 have also been amended to describe the second section of the cross-section as positioned “adjacent and outermost to the first section...” Support for this amendment is found in Fig. 4 where the first section is 45 and the second section is 46.



New claim 13 has been added, reciting that the measurements of the distance from the center line to the first flank and the center line to the second flank are made along the same plane. Support for this claim is found in the specification at page 3, lines 7-16 and in Figs. 2 and 4.

New claim 14 has been added. Support for this claim is provided in originally filed claims 5 and 6 and in Fig. 3 of the application, which shows a dovetail shape of the connecting element, which

exposes the second section of the second flank towards the opposite flank of the recess. Claim 14 contains a recitation that the second contact point (62) is positioned on the rounded part of the second flank.



Thus, upon entry of the amendments, claims 1-14 will be pending and under examination.

### **Rejection of Claims 1-12 Under 35 U.S.C. §102**

The examiner has rejected claims 1-12 under 35 U.S.C. §102(b) as being anticipated by Otto et al. (DE19933343). Applicants respectfully disagree.

Anticipation of a claim requires the disclosure in a single prior art reference of each element of the claim under consideration. (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987.)

The shape of the claimed connecting element is derived from a dovetail shape, with flanks widening from the root. Claim 1 has been amended to recite "...the cross-section of the connecting element is widened from the root region of the connecting element throughout the first section." Independent claim 11 recites "comprising a root region of the connecting element..."

Otto et al. however, describes a connecting element bordered by parallel opposite flanks resulting in a constant width of the connecting element in the first section. Contrary to the recitation of independent claims 1 and 11 of the present application that the first flank has an outward inclination from the root region near the utilization side toward the counter draw, Otto et al. describes an inward inclination of the first flank in the first section (see Figs. 1 and 2). Otto et al. do not describe a panel element "...comprising a root region of the connecting element..." where when viewed from utilization side to counter draw "...the cross-section of the connecting element is widened from the root region of the connecting element through the first section..."

as such Otto et al. do not anticipate independent claim 1 or 11. Since all of claims 2-10, 12 and 13 depend from claims 1 or 11, those claims contain all limitations of the claims from which they depend and are therefore not anticipated by Otto et al.

With regard to dependent claim 3, the present application recites that "...the first flank has an angle inclination smaller in the first section than that of the second flank in the first section." Otto et al. however, describe a first flank 11 and second flank 12 with the same inclination (10°). See Otto et al. col. 3, lines 15-17 (translated to: "the flanks of the groove and of the tongue at an angle of appr. 10° to the orthogonal") and col. 3, l. 65 to col. 4, l. 4 (translated to: "the groove 7 is bordered by the flanks 8, 9, which are at an angle of appr. 10° to the orthogonal A of the plane E of the panel. At the edge 6, the panel 2 has a tongue 10 which contour substantially corresponds with the contour of groove 7, wherein the flanks 11, 12 of the tongue 10 are at an angle of appr. 10° to the orthogonal A, also.")). Otto et al. do not describe a panel element where the inclination of the first flank is different than that of the second flank in the first section, as is claimed in claim 3.

Dependent claim 6 of the present application recites the panel element of claim 1 in a tongue and groove connection, where "the connecting element with the first and second flank of the another similar panel element is inserted into the recess of the groove, wherein a first contact point is formed between the first flank of the connecting element of the another similar panel element and the groove and a second contact point is formed between the second flank of the connecting element of the another similar panel element and the groove essentially opposite to the first contact point."

Fig. 2 of Otto et al. illustrates a connection where the first flank of the connecting element is not in contact with the opposite flank of the recess in a locked tongue and groove system. While Fig. 2 of Otto et al. shows a contact point, it is on a plane parallel to the utilization side. Claim 6 of the present application recites a contact point located on the first flank, within the recess, rather than a contact point located on the plane surface parallel to the utilization side and outside the recess, as shown in Otto et al. and relied upon by the examiner. Otto et al. clearly does not anticipate claim 6.

Since Otto et al. do not describe a panel element or interlocking floor system as set forth in claims 1-12, Otto et al. does not anticipate the claimed invention. Accordingly, withdrawal of the rejection of claims 1-12 under 35 U.S.C. § 102 (b) as being anticipated by Otto et al. is

respectfully requested.

**Rejection of Claim 10 Under 35 U.S.C. §103**

Claim 10 is rejected under 35 U.S.C. §103(a) as being obvious over Otto et al. in view of U.S. Patent No. 5,797,237 (hereinafter Finkell).

It is elemental law that in order for an invention to be obvious, the difference between the subject matter of the application and the prior art must be such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art. In order to meet this standard for a proper §103 rejection, all claim limitations must be disclosed or derivable from the cited combination of references, there must be a logical reason to combine the cited references to produce an operable combination and there must be a reasonable expectation of success. (*See* MPEP §2143)

Rejected claim 10 depends from independent claim 1 and therefore contains all limitations of claim 1. As set forth in detail above, with regard to the rejection of claims 1-12 under 35 U.S.C. § 102(b), independent claim 1 is clearly not anticipated by Otto et al., as Otto et al. does not describe outward inclination of both the first and second flanks in the first section of the connecting element, as recited in claim 1 of the present application.

The Finkell reference is cited by the examiner in the Office Action mailed January 28, 2008 as “teach[ing] a ‘hydrophobic agent’ ...that is used to a [sic] least partially treat the panel elements to prevent deterioration by water infiltration.” (Office Action mailed January 28, 2008, page. 6.) Regardless of the teachings of Finkell, the combination of the Otto et al. and Finkell references fails to provide any derivative basis and does not disclose all elements of the panel element of claim 10. The combination of Otto et al. and Finkell does not describe a panel element containing a connecting element with outward inclination of both the first and second flanks in the first section of the connecting element. As such, the combination of Otto et al. and Finkell does not render the invention of claim 10 obvious.

Since Otto et al. in view of Finkell do not provide any logical basis for the panel element recited in claim 10, Otto et al. in view of Finkell does not render the claimed invention obvious. Accordingly, withdrawal of the rejection of claim 10 under 35 U.S.C. § 103(a) as being obvious over Otto et al. in view of Finkell is respectfully requested.

**Fees Payable for Added Claims**

By the present Amendment, two new dependent claims have been introduced, however the total number of pending claims remains below 20. As such no fees are due for addition of new claims 13 and 14.

**CONCLUSION**

Based on the foregoing, all of Applicants' pending claims 1-14 are patentably distinguished over the art, and are in form and condition for allowance. The Examiner is requested to favorably consider the foregoing and to responsively issue a Notice of Allowance.

No fees are believed to be due for the filing of this paper. However, should any fees be required or an overpayment of fees made, please debit or credit our Deposit Account No. 08-3284, as necessary.

If any issues require further resolution, the Examiner is requested to contact the undersigned attorney at (919) 419-9350 to discuss same.

Respectfully submitted,

Date: April 28, 2008

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